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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,191	11/28/2000	Satoshi Machino	70868-55282	7748

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EXAMINER	
COFFY, EMMANUEL	
ART UNIT	**PAPER NUMBER**
2157	7

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary	Application No	Applicant(s)	
	09/724,191	MACHINO ET AL.	
	Examiner	Art Unit	
	Emmanuel Coffy	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 November 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with sentences, which are not clear, concise and exact.

A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because of ambiguous language from a direct translation. Examples of some unclear, inexact or verbose terms used in the specification are: In page 5, ¶1 it states: "a storage section for storing a destination table in which destination records in each of which an address of an e-mail destination notation are correlated with each other are registered and a group table in which group records in each of which an identification name of a group and one or a plurality of destinations are correlated with each other are registered." This paragraph epitomizes direct translation from a foreign language. In page 5, ¶2 it states:" a control section having a destination classification function of classifying, when a group is designated as destinations..."

The specification is unclear, ambiguous and incomprehensible.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c).

2. The Abstract of the disclosure is objected to because it begins with language that can be implied. Correction is required. See MPEP § 608.01 (b).

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes etc..." In this case the language:" It is intended" can be implied.

3. Figure 7 of the drawings is objected to because it contains a spelling error. The word "LLISTED" in "DETECT LLISTED n3" should be replaced with LISTED. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-20 are rejected.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. §112 ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention due to ambiguous language from direct translation. A reasonable artisan skilled in the art could not comprehend the claims as written. The claim recites: "a storage section for storing a destination table in which destination records in each of which an address of an e-mail destination notation are correlated with each other are registered and a group table in which group records in each of which an identification

name of a group and one or a plurality of destinations are correlated with each other are registered." It is not clear what the boundary of the claim is. Hence, the scope of the claim is unascertainable.

However, in order to provide a more complete examination the Examiner asserts that this invention is understood as: "an electronic mail apparatus comprising a storage section and a control section. The former uses a destination table and a group table in determining mail recipients. The latter incorporates a classification function that filters which e-mail is actually transmitted."

5. Claims 2-20:

Above claims are rejected by virtue of their dependency on claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-2, 7-9, 17-20 are further rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi ('448) in view of Miller et al ('241).

a) Claim 1 of the present invention recites a storage section and a control section. The former is used for storing a destination table containing destination records. These records store address of an e-mail destination and a destination notation

correlated with each other. The latter incorporates a classification function that filters which e-mail is actually transmitted. In Fig 1, Yamauchi discloses a mail handler (2) and a storage section (3). The former controls a correspondence between a destination name and a mail address (column3 lines 9-55). The latter incorporates an automatic transfer destination function, which determines whether the destination name is listed, or not. For example, in the system address book a corresponding mail address is designated for the destination name "President."

Yamauchi does not teach the use of multiple tables. However, Miller discloses the use of message-correspondent relationship data table and message data table in order to efficiently manage e-mail to multiple addresses. (See column 14, lines 15-35).

It would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the use of multiple tables taught by Miller with the automatic transfer destination function disclosed by Yamauchi. Such a system would greatly alleviate the burden on the user by reducing the time consumed to set-up, maintain and use the system for frequently transmitted e-mails. Hence, a user would enjoy the benefits of:

(a) avoiding the inconvenience of remembering or looking up e-mail addresses; and

(b) having their e-mail organized automatically by the system rather than having to organize it manually.

The system would use multiple tables namely a message-correspondent relationship data table and message data table producing an automatic transfer unit for

handling electronic mail. Address books provided for each user would be used to manage a plurality of entries, each entry including one or more destination names having corresponding mail; addresses and a control section to retrieve and search address book for a key word and to transfer the mail message to the mail address corresponding to the key word.

b) Claim 2:

As for claim 2, it recites the designation of a group of destinations as designations of the e-mail message based on attribute information of the e-mail message. Likewise, Yamauchi teaches that the user address book is scanned for addresses that match a keyword (column 4, lines 31-41). When there is a match, the mail message is transferred to the mail address corresponding to the destination (column 4, lines 45-49). Yamauchi therefore, anticipates the present invention and claim 2 is rejected.

c) Claims 7, 8 and 9:

The above claims recite the classification of e-mail destinations based on whether the destinations are listed in a prescribed region of the e-mail message to be transmitted. Yamauchi teaches a system for automatic transfer of electronic mail to a destination taken from the "To" field of the message (column 4, lines 52-67). The "To" field is a prescribed region of the e-mail message where destinations are listed (column 2 lines 59-68); therefore, claims 7, 8 and 9 are rejected.

d). Claims 17, 18, 19 and 20:

These claims recite the function of updating a designated group with a new member. Yamauchi teaches a system for automatic transfer of electronic mail to a destination where the automatic transfer destination names are updatable (column 6, lines 31-33); therefore, claims 17, 18 19 and 20 are rejected.

7. Claims 3 and 4:

The above claims are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi ('448) in view of Miller et al ('241) as applied to claim 1 above, and further in view of McCormick.

The claims recite the prohibition of e-mail messages to identified destinations. The combined teachings of Yamauchi and Miller does not explicitly teach such limitation however, McCormick teaches that any e-mail received by the user is checked against the automatic discard filter to determine whether to discard that e-mail. If true, the email is eliminated (column 4, lines 21-26). It is inherent that the converse is true namely the automatic discard filter could very well be a destination address.

It would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the use of automatic discard filter taught by McCormick with the automatic transfer destination function disclosed by Yamauchi and Miller. Such a system would be very flexible hence, ease of operation is augmented.
The user would enjoy the benefit of an e-mail system less prone to transmission errors.

As stated above, the system would perform the additional function of excluding certain members of a group from receiving certain mail.

8. Claims 5 – 6, 10-16:

The above claims are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi ('448) in view of Miller et al ('241) as applied to claim 1 above, and further in view of Shaw et al ('565).

a) Claims 5 and 6 recite the subclassification of e-mail destinations based on a preset condition. The combined teachings of Miller and Yamauchi does not teach such limitation however, Shaw teaches an electronic mail system using a set of configurable rules that examine each message for a specific attribute state condition and invoke an action based on whether the preset condition is satisfied (column 4, lines 28-67).

It would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the use of configurable rules taught by Shaw with the automatic transfer destination function disclosed by Yamauchi and Miller. Such a system would be accurate and efficient. The task of attending to each and every e-mail is simplified as the system performs these rule-based tasks.

b) Claims 10, 11, 12 and 13:

These claims recite transmission of an e-mail message to a destination even though the destination is not correlated with the designated group. Yamauchi does not

teach such limitation however, Shaw teaches an enterprise email management system which allows email messages to be handled automatically in a variety of manners including routing the email message to a particular user or destination (column 4, lines 28-38). A destination not correlated with the designated group is a particular user.

It would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the use of enterprise email management system taught by McCormick with the automatic transfer destination function disclosed by Yamauchi. Such a system would be flexible yet accurate. It would be flexible enough to allow particularize service yet accurate in that every party is served according to their needs or ranking.

The system could be tailored to a particular user or destination.

c) Claims 14, 15 and 16:

Claims 14, 15 and 16 recite transmission of stored transmitted e-mail message to a destination even though the destination is not correlated with the designated group. Yamauchi fails to teach such limitation however, Shaw teaches an enterprise email management system which allows email messages to be handled automatically in a variety of manners including forwarding stored e-mail messages (column 4, lines 28-38) to certain users.

It would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the use of enterprise email management system taught by McCormick with the automatic transfer destination function disclosed by Yamauchi.

Rather than having to recreate an e-mail message, this ability to forward stored e-mail messages alleviates the burden imposed on a user. This feature would be desirable in an e-mail system.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Funk et al. (U.S. 5,937,162) teaches "Method and Apparatus for High Volume e-mail delivery."
- Miloslavsky (U.S. 6,128,646) teaches " System for routing electronic mail to best qualified person based on content analysis."
- Takahashi et al. (US 6,442,589) teaches " Method and system for sorting and forwarding electronic messages and other data."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (703) 305-0325. The examiner can normally be reached on 8:30 - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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EC
April 16, 2004

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